

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Examiner makes no prior art rejections of claims 4, 5, 7, 8, and 10. Therefore, Applicants assume that the same contain allowable subject matter.

In the Official Action, the Examiner rejects claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, with regard to claims 1 and 11, the Examiner argues that it is unclear how the force adjustment portion differs from the already claimed holder tube and hold member. Applicants respectfully submit that the holder tube and the hold member comprise the force adjustment portion recited in claims 1 and 11. Thus, independent claims 1 and 11 have been amended to clarify the same.

With regard to claim 10, the Examiner argues that the phrase "40 degree or lower" is unclear. In response, claim 10 has been amended to clarify the same. Specifically, claim 10 has been amended to depend from claim 9 and further amended to clarify that the objectionable phrase refers to a rubber hardness of the soft flexible material.

Further in regard to claim 11, the Examiner argues that there is no antecedent basis for the phrase "the connected portion." In response, the phrase "the connected portion" has been changed to --a connected portion--.

Accordingly, it is respectfully requested that the rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner objects to the drawings as failing to comply with 37 C.F.R. § 1.83(a) because the drawings do not show every feature of the

invention specified in the claims. Specifically, the Examiner argues that the hold member having a solid part in the rear of the holder tube and a hollow part in the front side ahead of the solid part must be shown or the features canceled from the claim. In response, Applicants respectfully submit that the features of claim 4 are shown in Figure 3 of the Drawings. Specifically, Figure 3 illustrates a hold member having "a solid part 42 is placed in the rear end side in the holder tube 5" and "a cylindrical part 44 formed with a hollow part 43 at the axial center is placed nearer to the front end than the solid part 42" (see page 18, lines 8-16).

Accordingly, it is respectfully requested that the objection to the drawings under 37 C.F.R. § 1.83(a) be withdrawn.

In the Official Action, the Examiner rejects claims 1-3, 9 and 11 under 35 U.S.C. § 102(b) as being anticipated by European Patent No. 0 738 501 A1 to Matsuno et al., (hereinafter "Matsuno"). Furthermore, the Examiner rejects claims 1, 3, 6, 9, and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0045909 A1 to Kimura et al., (hereinafter "Kimura").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 102(e) for at least the reasons set forth below. Furthermore, independent claims 1 and 11 have been amended to broaden the scope thereof in light of the teachings of the cited prior art and to cover at least all of the disclosed embodiments of the original disclosure.

Specifically, original independent claims 1 and 11 recite "adjusts the force of the clipping operation in the state of relatively increasing a ratio of a clip closing force...a clip opening force...." However, the original disclosure (at the fifth and sixth embodiments) also teaches the above ratio being decreased. Therefore, independent claims 1 and 11 have been

amended to recite "wherein the holder tube and the hold member comprise a force adjustment portion which adjusts a ratio of a clip closing force to close the clip hands to a clip opening force to expand the clip hands." The amendment to claims 1 and 11 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to claims 1 and 11.

In the Official Action, the Examiner argues that all of the features of independent claims 1 and 11 are shown in the references. However, the Examiner ignores the features with regard of the adjustment of the ratio of a clip closing force to close the clip hands to a clip opening force. The Examiner makes no showing that such a features is shown or suggested in the cited references. Applicants respectfully submit that the cited references do not disclose or suggest that the ratio of the clip closing force to the clip opening force is adjusted (to either increase or decrease the same).

With regard to the rejection of claims 1-3, 6, 9, and 11 under 35 U.S.C. §§ 102(b) and 102(e), a clip device for holding a living tissue having the features discussed above and as recited in independent claims 1 and 11, is nowhere disclosed in either Matsuno or Kimura. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 1 and 11 are not anticipated by either Matsuno or Kimura. Accordingly, independent claims 1 and 11 patentably distinguish over both Matsuno and Kimura and are allowable. Claims 2, 3, 6, and 9 being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3, 6, 9, and 11 under 35 U.S.C. § 102(b).

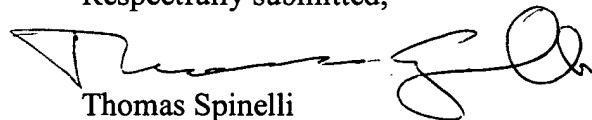
¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Furthermore, independent claims 1 and 11 have been amended to change the term "filled" to --disposed-- to improve their form and readability. No new matter has been entered into the disclosure by way of the further amendment to claims 1 and 11.

Lastly, new claims 12 and 13 have been added to recite that the ratio of the clip closing force to the clip opening force can be adjusted to increase or decrease. Each of claims 12 and 13 depend from independent claim 1 and are fully supported in the original disclosure. Thus, no new matter has been entered into the original disclosure by way of the addition of new claims 12 and 13. New claims 14-21 have also been amended to depend from claim 13 (either directly or through an intervening claim). New claims 14-21 are fully supported in the original disclosure, particularly at original claims 2-9. Thus, no new matter has been entered into the original disclosure by way of the addition of new claims 14-21. Claim 2 has also been amended to depend from new claim 12 so as to be consistent with its amended base claim.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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